cosmetically acceptable medium, at least one wax having a tack of greater than or equal to 0.7 N.s and a hardness of less than or equal to 3.5 MPa, *and at least one compound chosen from dextrin esters of fatty acids and/or at least one filler having a BET specific surface area of greater than or equal to 100 m2/g* [sic] classified in class 424, subclass 70.1.

III. Claim 112 is drawn to a non-therapeutic cosmetic process for making up keratin fibers materials at least one composition comprising, in a cosmetically acceptable medium, at least one wax in an amount of at least 27% by weight classified in class 424, subclass 70.7.

IV. Claim 113 is drawn to a non-therapeutic process for making up keratin materials comprising applying to the keratin materials at least one composition comprising, in a cosmetically acceptable medium, at least one wax having a tack of greater than or equal to 0.7 N.s and a hardness of less than or equal to 3.5 MPa, and at least one compound chosen from dextrin esters of fatty acids and/or at least one filler having a BET specific surface area of greater than or equal to 100 m2/g. [sic] classified in class 424, subclass 70.7.

V. Claim 114 is drawn to a process for *obtaining a charging and separating makeup result on the eyelashes* comprising applying to the eyelashes at least one composition comprising, in a cosmetically acceptable medium, at least one wax in an amount of at least 27% by weight, relative to the total weight of the composition, wherein said at least one wax has a tack of greater than or equal to 0.7 N.s and a hardness of less than or equal to 3.5 MPa classified in class 424, subclass 70.7.

VI. Claim 115 is drawn to a process for *obtaining a charging and separating makeup result on the eyelashes* comprising applying to the eyelashes at least one composition comprising, in a cosmetically acceptable medium, at least one wax having a tack of greater than or equal to 0.7 N.s and a hardness of less than or equal to 3.5 MPa, and at least one compound chosen from dextrin esters of fatty acids and/or at least one filler having a BET specific surface area of greater than or equal to 100 m2/g [sic] classified in class 424, subclass 70.7.

> [VII]. Claims 116-117 are drawn to an assembly (1) for packaging and applying a product for coating keratin fibres, comprising: i) a container (2) containing the composition according to Claim 1, and ii) means (12), for applying the composition to the fibres classified in class 132, subclass 1+.

Dec. 14, 2006, Office Action, at 2-3 (emphasis in original).

Applicants respectfully traverse the restriction requirement, as set forth above and on pages 2-6 of the Office Action. However, to be fully responsive, Applicants elect, with traverse, the subject matter of Group I, comprising claims 1-24 and 79-107.

In addition, the Examiner requires Applicants to elect a "single disclosed species belonging to wax" and a "wax belonging to additional wax." *Id.* at 6. The Examiner asserts that the present claims are "directed to the following patentably distinct species: belonging to wax[,]" which, according to the Examiner, "can be natural wax or synthetic wax or it can be compounds of formula I." *Id.* at 7. Applicants respectfully traverse this election requirement as set forth on page 7 of the Office Action. However, to be fully responsive, Applicants elect, with traverse, the "species" drawn to waxes of formula (I) as "belonging to wax," and carnauba wax as the "additional wax." The Examiner asks for "a listing of all claims readable" on the election of species. *Id.* Thus, Applicants note that while claims 11 and 21 specifically recite the elected species, all claims of the restricted Group, i.e., claims 1-24 and 79-107, are readable thereon.

The Examiner admits that "[i]nventions I and III-VI are related as product and process of use," and that "[i]nventions [VII] and I are related as apparatus and product

made." *Id.* at 4.[1] However, the Examiner asserts that the inventions are distinct because, with respect to Groups I and III-VI, the Examiner asserts that "[i]n the instant case the process for using the product as claimed can be practiced with film forming polymer like PVP/VA and also the process of use can be practiced with two different products of group I and group II." *Id.* With respect to Groups VII and I, the Examiner asserts that "[i]n this case the product as claimed can be practiced with an assembly containing a container and the container containing the composition and the container containing curved brush for coating the keratin fibers." *Id.* at 4-5. Applicants disagree.

Applicants respectfully refer the Examiner to M.P.E.P. § 803, which sets forth the criteria and guidelines for Examiners to follow in making proper requirements for restriction. The M.P.E.P instructs the Examiner as follows:

> If the search and examination of all the claims in an application can be made **without serious burden**, the examiner **must** examine them on the merits, even though they include claims to independent or distinct inventions.

M.P.E.P. § 803 (emphasis added).

Here, the Examiner has not shown that examining Groups I-VII together would constitute a serious burden. Rather, the Examiner admits that various groups are related as: product and process of use (Groups I and III-VI, *see* Dec. 14, 2006, Office Action, at 4), and apparatus and product made (Groups VII and I, *see id.*). The Examiner contends that the above related groups can also be distinct, but does not

[1] In the restriction requirement, the Examiner listed Group VI twice. *See* Dec. 14, 2006, Office Action, at 3. Applicants' believe that the Examiner intended to identify the second Group VI, directed to an assembly, as Group VII.

specify what serious burden will be placed on the Examiner if she were to proceed in examining the groups together, as required by M.P.E.P. § 803.

Further, Applicants respectfully submit that, at a minimum, examining the claims of Groups I and III-VI together would not impose a serious burden. M.P.E.P. § 803 states that "a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation of separate classification." In contrast, the Examiner indicates that Groups I and III-VI fall into the same "class 424, subclass 70.7." *Id.* at 2-3.

Additionally, Applicants submit no serious burden would exist in light of the requirement of rejoinder. *See* M.P.E.P. § 821.04. Accordingly, it is unclear what burden is on the Examiner to examine at least the claims of Groups I and III-VI together, and Applicants respectfully request withdrawal of the restriction requirement.

Moreover, Applicants respectfully traverse the election of species requirement, at least because the Examiner, similar to the Restriction Requirement, has failed to show that a serious burden exists to examine all of the alleged species. To make a proper requirement for an election of species the Examiner must, inter alia, show that the search and examination of a claim would impose a serious burden on the Office because it embraces an unreasonable number of species. M.P.E.P. § 803.02 (emphasis added). Here, the Examiner has provided no reasons or evidence on the record to substantiate the election of species requirement, let alone how examination of all the species would impose a serious burden. It can hardly be said that the three alleged species (belonging to wax) or that the six alleged species (for additional wax)

are an "unreasonable" number. Thus, there is truly no burden on the Examiner to examine the two defined species together.

If the Examiner chooses to maintain the election of species requirement, Applicants expect the Examiner, if the elected species is found allowable, to continue to examine the full scope of the elected subject matter to the extent necessary to determine the patentability thereof, *i.e.*, extending the search to a "reasonable" number of the non-elected species, as is the duty according to M.P.E.P. § 803.02 and 35 U.S.C. § 121. Accordingly, it is unclear what burden is on the Examiner to examine all claimed species together, and Applicants respectfully request withdrawal of the Restriction Requirement.

If there is any fee due in connection with the filing of this Statement, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

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